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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/869, 275 06/04/97 WITTMER

C T8616.CIPS

HM12/1109

EXAMINER

BARNES & THORNBURG  
11 SOUTH MERIDIAN STREET  
INDIANAPOLIS IN 46204

MARSCHEL, A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED:

11/09/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
08/869,275

Applicant(s)

Wittmer et al.

Examiner

Ardln Marschel

Group Art Unit

1631



Responsive to communication(s) filed on Aug 9, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 13-35, 55-59, 79-82, 87-92, and 118-155 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) 33-35, 55-59, 79-82, 87-92, 118-121, and 145-151 is/are allowed.

Claim(s) 13-32, 122, 124-144, 152, 153, and 155 is/are rejected.

Claim(s) 123 and 154 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Exhibit(s) (1 sheet)

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

Applicants' arguments, filed 8/9/00, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 13-32, 122, 124-144, 152, 153, and 155 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the first 2 lines of claim 13, the phrase "in real time" is present. Confusingly, there, however, are no "real time" components cited in the claim thus making the meaning of having this in the preamble of the claim and not related to something specific in the system confusing as to what is meant regarding the metes and bounds of this phrase. Clarification via clearer claim wording is requested. This unclarity also exists in the other claims listed above either directly or indirectly due to their dependence from a claim which contains it.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 13, 18, 20, 28, 128, 129, and 140 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either of Jerman (P/N 5,824,204) or Schnipelsky et al. (P/N 5,229,297).

Both of these references perform PCR amplification wherein means for positioning sample and heating and cooling for such amplification are described such as in the abstract of Schnipelsky et al. or in Jerman at column 4-5, bridging paragraph. Both references also permit the monitoring of the resultant products via transparent windows in their system such as given in Jerman at column 6, lines 32-42, or in Schnipelsky et al. at column 14, lines 10-22. Jerman specifically cite and suggest real time monitoring in column 5, lines 31-37. It is noted that the sample container of the instant claims are not

limited regarding being related as to use either during either amplification or detection. It is also noted that the Figures of each reference depict system components with sides, ends, etc. as also required in the instant claims. Optical detection of nucleic acids motivates and suggests the extremely well known and common labeling for such practice being fluorescence which would normally be optimized for detection as required in instant claim 20.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice the instant invention because both references describe a system as instantly claimed with optical detection which motivates and suggests fluorescence as an extremely well known type of such detection.

Claims 123 and 154 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The citation FB on the 1449, executed 11/8/99, has been lined through thereon so as to replace it with the FB citation with the correct date of publication as given on the 1449 mailed herewith. Reference ET is again lined through on the 1449 mailed herewith due to still lacking a date of publication. The remaining citations are lined through on the enclosed Form 1449 to avoid duplication of citation because they were already

previously initialed and cited on the 1449, considered 11/8/99.

Claims 33-35, 55-59, 79-82, 87-92, 118-121, and 145-151 are allowed.

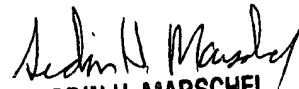
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Ce-0nter located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

November 3, 2000

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER